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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,622	06/09/1999	KEITH ALAN MARSHALL	BO9-99-014	7058
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GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER SAFAIPOUR, HOUSHANG	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 04/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/328,622

Applicant(s)

MARSHALL ET AL.

Examiner

Houshang Safaipoor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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**DETAILED ACTION**

***Response to Arguments***

Applicant's amendment filed on January 24, 2004, has been entered and made of record.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4, 5, 8, 11, 14, 15, 18, 21, 24 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (U.S. Patent No. 5,974,449).

Regarding claim 1, Chang et al. discloses a method of managing the distribution of facsimile messages to a recipient, comprising:

receiving a message from a transmitting facsimile via a telephone network message comprising receiving fax server telephone number appended with a recipient direct dial telephone number; automatically parsing the message to extract the recipient direct dial telephone number from the message; receiving a fax payload from the transmitting facsimile in the fax server; determining an e-mail address and at least one recipient fax preference from the direct dial telephone number; processing the fax payload according to the recipient fax preference; and directing the processed fax message according to the recipient fax preference (col. 9, line 20 through col. 11, line 44).

Regarding claim 4, Chang et al. discloses the method of claim 1, wherein the step of automatically parsing the message to extract the recipient direct dial telephone number from the message is performed by a processor responding to instructions to extract the recipient direct dial telephone number from the message (col. 9, line 20 through col. 11, line 44).

Regarding claim 5, Chang et al. discloses the method of claim 1, wherein the step of determining an e-mail address and at least one recipient fax preference from the direct dial telephone number comprises the steps of:

calling an application program interface in the fax server to an application managing recipient information comprising the e-mail address and the direct dial telephone number of the recipient; and searching the recipient information for the e-mail address corresponding to the direct dial telephone number (col. 10 line 40 through col. 11 line 44).

Regarding claim 8, Chang et al. discloses the method of claim 1, wherein the fax preference describes forwarding fax information, and the method further comprises the step of forwarding the fax message according to the forwarding fax information (col. 9, line 20 through

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col. 11, line 44).

Regarding claims 11, 14, 15 and 18 arguments analogous to those presented for claims 1, 4, 5 and 8 are applicable to claims 11, 14, 15 and 18 respectively.

Regarding claims 21, 24, and 27 arguments analogous to those presented for claims 1, 5 and 8 are applicable to claims 21, 24, and 27 respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449).

Regarding claim 3, utilizing fax cards with facsimile apparatus is well known in the art and is routinely implemented in facsimile operation (Official Notice). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include this feature in Chang's system, because this addition would enhance Chang's's design and would add more options for the subscribers.

Regarding claims 13 and 23, arguments analogous to those presented for claim 3 are applicable to claims 13 and 23.

Claims 2, 12 and 22 are rejected as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449) and further in view of Brossman et al. (U.S. Patent No. 6,498,661).

Regarding claim 2, Chang et al. does not disclose the method of claim 1, wherein the step of processing the fax payload in the fax server according to the recipient fax preference comprises the steps of:

reading a grayscale transform from a memory accessible to the fax server; and applying the grayscale transform to the fax payload. Brossman et al. discloses a system with capability of applying the grayscale transform to the fax payload (col. 12, lines 4-25). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include Brossman's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers.

Regarding claims 12 and 22 arguments analogous to those presented for claim 2 are applicable to claims 12 and 22.

Claims 6, 16 and 25 are rejected as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449) and further in view of Reifman (U.S. Patent No. 5,917,615).

Regarding claim 6, Chang et al does not disclose the method of claim 1, the message further comprises a transmitting facsimile identification and wherein the fax preference describes an identification of a junk fax source, and the step of processing the converted fax message according to the recipient fax preferences comprises the step of deleting the received fax payload if the transmitting facsimile identification corresponds to the identification of the junk fax source. Reifman discloses a system capable of eliminating junk facsimile messages (col. 33, lines 40-55). Therefore, it would have been obvious to a person of an ordinary skill in the art at the

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time the invention was made to include Reifman's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers.

Regarding claims 16 and 25 arguments analogous to those presented for claim 6 are applicable to claims 16 and 25.

Claims 7, 17 and 26 are rejected as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449) and further in view of Bobo, II (U.S. Patent No. 5,675,507).

Regarding claim 7, Chang et al. does not disclose the method of claim 1, wherein the fax preference describes a preferred portable document format, and the step of processing the fax payload in the fax server comprises the step of converting the fax payload to the preferred portable document format. Bobo discloses a system capable of converting the fax messages to portable document format (col. 11, lines 24-31). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include Bobo's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers.

Regarding claims 17 and 26 arguments analogous to those presented for claim 7 are applicable to claims 17 and 26.

Claims 9, 10, 19, 20, 28 and 29 are rejected as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449) and further in view of Choksi et al. (U.S. Patent No. 6,477,243).

Regarding claim 9, Chang et al. does not disclose the method of claim 1, further comprising the step of transmitting a confirming message to the transmitting facsimile. Choksi et al. discloses a system capable of transmitting a confirming message to the transmitting facsimile (col. 6, lines 66-67 and col. 7, lines 1-17). Therefore, it would have been obvious to a person of

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an ordinary skill in the art at the time the invention was made to include Choksi's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers

Regarding claim 10, Chang et al. does not disclose the method of claim 9, wherein the confirming message comprises a portion of the fax payload. Choksi et al. discloses a system capable of transmitting a confirming message to the transmitting facsimile (col. 6, lines 66-67 and col. 7, lines 1-17). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include Choksi's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers

Regarding claims 19 and 28 arguments analogous to those presented for claim 9 are applicable to claims 19 and 28.

Regarding claims 20 and 29 arguments analogous to those presented for claim 10 are applicable to claims 20 and 29.

Claims 30-32 are rejected as being unpatentable over Chang et al. (U.S. Patent No. 5,974,449) and further in view of Lee et al. (U.S. Patent No. 5,007,054).

Regarding claim 30, Chang et al. does not disclose the method of claim 1, further comprising the step of: detecting whether the faxload is essentially identical to an earlier received fax payload. Lee et al. discloses such a system (col. 8, lines 59-65). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include Lee's design in Chang's system, because this addition would enhance the design and would add more options for the subscribers



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Regarding claims 31 and 32 the arguments analogous to those presented for claim 30 are applicable to claims 31 and 32.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-0377.

Houshang Safaipoor  
Patent Examiner  
Art Unit 2622  
April 4, 2004

  
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